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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,315	11/30/1999	DALE F. MCINTYRE	79909F-P	8863

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EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AW

Office Action Summary	Application No.	Applicant(s)	
	09/451,315	MCINTYRE ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/20/05.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 11, 12, 16, 17, 26, 27, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick (US5553864) in view of Thacher et al (US5917725).

Regarding claims 1, 11, 16, 26, 31, Sitrick teaches a computer gaming device that enables a user to include user-supplied images into the gameplay of the computer game [14:2-9]. Sitrick teaches that the images can be provided as scanned photos [2:8-15, 25:39-43] or by digitization of user-supplied photos/film by a service bureau such as the Kodak photoCD system [5:41-59, 10:26-44, 13:33-38, 26:3-53]. Sitrick does not specify any particular message to be displayed at the conclusion of the game. Thacher et al teaches networked tournament computer games whereby when the games end results of the games as well as advertising are displayed to the users [abstract, 4:1-4, 8:1-20]. These various types of displayed content are taken to be "messages." It would have been obvious to one of ordinary skill at the time of the invention to have provided the games of Sitrick in a networked gaming environment so that tournaments can be

held between players and results of the tournament games as well as advertising can be displayed to the players.

Regarding claims 2, 17, 32, 33, Thacher et al teaches that tournament results as well as player data (available credits) and a menu of player selection options is stored at a central server [7:5-27]. The player's gaming device accesses the central server for these purposes and these acts are taken to provide forwarding the user to a remote computer. It would have been obvious to one of ordinary skill at the time of the invention to have forwarded the user to the server at the conclusion of the games in order to display current tournament results, as well as to display any remaining credits the player has as well as to offer the user to choose from the server's menu options so that the player can play another game.

Regarding claims 12, 27, Sitrick teaches that the images could be provided on a CD or by remote connection over a network [11:36-42, 13:39-45].

4. Claims 3-6, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick in view of Thacher et al and Walker et al (US6203427).

Walker et al also teaches computer games. Each game/contest includes a gameID, customerID and winning information. The winning information is also encrypted [fig 11b, col 9 lines 1-25]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such game/contest identification means so that a winning player must verify the authenticity of the winning contest by any well known means such as by phone or computer, so as to eliminate fraudulent tournament

scores. Official Notice is taken that encryption is used when transmitting data for security and authenticity. It would have been obvious to one of ordinary skill at the time of the invention to have encrypted the contest and winning information to further secure against tournament fraud.

5. Claims 7, 8, 10, 13-15, 22, 23, 25, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick in view of Thacher et al and Small.

Regarding claims 7, 8, 10, 22, 23, 25, the tournament computer game competition of Sitrick does not appear to include coupons as prizes. However Small teaches computer games that enable winners to receive prizes as well as receiving coupons [7:34-57]. Small teaches a computer game whereby a user is provided discount coupons and/or rebate information at the conclusion of the game; the user is then able to print coupons and rebate information [7:50-57]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a promotion/advertising/coupon component as taught by Small with the game of Sitrick/Thacher et al in order to provide sponsorship for the game, so as to add consumer value and/or to generate revenue or to offset costs for providing the game.

Regarding claims 13-15, 28-30, Sitrick does not appear to limit the invention to any particular type of computer gameplay. Small provides a computerized matching game with images covering "hidden" tiles. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that other match games can be used instead

[col 9 lines 12-15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been obvious to one of ordinary skill at the time of the invention to have provided any type of computer game including the games of Small and/or "Concentration" in order to provide a variety of experiences. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have to have provided the known Concentration matrix as one which is square as a matter of design choice.

6. **Claims 9, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick in view of Thacher et al, Small and Barnett et al (US6336099).** Small does not take steps to prevent a user from printing multiple copies of coupons. Barnett et al also teaches electronic coupon distribution, but takes steps to ensure coupons can only be printed once [col 5 lines 47-62]. It would have been obvious to one of ordinary skill at the time of the invention to have prevented users from printing awarded coupons more than once, so as to eliminate fraud and to encourage playing multiple games, thus being subjected to more sponsorship promotion.

7. Claims 1, 11, 12, 16 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick (US5553864) in view of Bernstein et al (US4314336).

Regarding claims 1, 11, 16, Sitrick teaches a computer gaming device that enables a user to include user-supplied images into the gameplay of the computer game [14:2-9]. Sitrick teaches that the images can be provided as scanned photos [2:8-15, 25:39-43] or by digitization of user-supplied photos/film by a service bureau such as the Kodak photoCD system [5:41-59, 10:26-44, 13:33-38, 26:3-53]. Sitrick does not specify any particular message to be displayed at the conclusion of the game. However, Bernstein et al teaches a computer video game whereby the score is displayed to the user at the end of the game. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the score/results of the game in order to communicate how well the player did at the game. Such a display is taken to be a message.

Regarding claim 12, Sitrick teaches that the images could be provided on a CD or by remote connection over a network [11:36-42, 13:39-45].

8. Claims 13-15 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick (US5553864) in view of Bernstein et al (US4314336) and Small (US5791991).

Regarding claims 13-15, Sitrick does not appear to limit the invention to any particular type of computer gameplay. Small provides a computerized matching game with images covering "hidden" tiles. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that other match games can be used instead [col 9 lines 12-

15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been obvious to one of ordinary skill at the time of the invention to have provided any type of computer game including the games of Small and/or "Concentration" in order to provide a variety of experiences. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have to have provided the known Concentration matrix as one which is square as a matter of design choice.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Breslow et al (US4710873) teaches a computer video game whereby the player can have his picture taken by the gaming device and the image is included in the gameplay.
- Goldberg et al (US5823879) teaches computer games where players are exposed to product advertising.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc